



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,742	03/18/2004	Masakatsu Kiwada	011350-331	5356
21839 7590 01/16/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 01/16/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
debra.hawkins@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/802,742	KIWADA, MASAKATSU	
	Examiner	Art Unit	
	CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☒ Claim(s) 1-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/7/06.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20080103.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Chan S. Park

DETAILED ACTION

Information Disclosure Statement

1. An initialed and dated copy of Applicant's IDS form 1449, is attached to the instant Office action.

Claim Objections

The following quotations of 37 § CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

2. Claim 1 recites the limitation "image data" in lines 7, 12 and 15. It is unclear if this image data is referring to the image data recited in line 3. If they are the same, the examiner suggests amending the limitation to recite -- said image data --.

Claim 1 further recites the limitation "copy-prohibiting information exists" in lines 19 and 21. It is unclear if this copy-prohibiting information is referring to the copy-prohibiting information recited in line 9. If they are the same, the examiner suggests amending the limitation to recite -- said copy-prohibiting information exists --.

3. Claim 2 recites the limitation "copy-prohibiting information exists" in lines 4-5. It is unclear if this copy-prohibiting information is referring to the copy-prohibiting information recited in claim 1, line 9. If they are the same, the examiner suggests amending the limitation to recite -- said copy-prohibiting information exists --.

4. Claim 3 recites the limitation "image data" in line 2. It is unclear if this image data is referring to the image data recited in claim 1, line 3. If they are the same, the examiner suggests amending the limitation to recite -- said image data --.

Claim 3 further recites the limitation "the electronically tagged printing paper" in lines 7-8. It is unclear if this printing paper is referring to the electronically tagged printing paper recited in line 4 of claim 1 or the electronically tagged printing paper recited in lines 2-3 of claim 3. The examiner notes that, in light of the Specification wherein on pages 21-22, this claimed limitation refers to the electronically tagged printing paper recited in lines 2-3 of claim 3. If the applicant agrees with the interpretation, the examiner suggests the following changes for a clarification:

Lines 2-3, "on electronically tagged printing paper" should be -- on another electronically tagged printing paper --; and

Lines 7-8, "the electronically tagged printing paper" should be -- the another electronically tagged printing paper --.

5. Claim 4 recites the limitation "electronic data" in lines 2-3. It is unclear if this electronic data is referring to the electronic data recited in claim 1, line 5. If they are the same, the examiner suggests amending the limitation to recite -- said electronic data --.

6. Claim 5 recites the limitation "image data" in lines 6-7, 15, 19 and 21. It is unclear if this image data is referring to the image data recited in line 3. If they

are the same, the examiner suggests amending the limitation to recite -- said image data --.

Claim 5 further recites the limitation "copy-prohibiting information exists" in line 22. It is unclear if this copy-prohibiting information is referring to the copy-prohibiting information recited in line 12. If they are the same, the examiner suggests amending the limitation to recite -- said copy-prohibiting information exists --.

7. Claim 6 recites the limitation "copy-prohibiting information exists" in line 4. It is unclear if this copy-prohibiting information is referring to the copy-prohibiting information recited in claim 5, line 12. If they are the same, the examiner suggests amending the limitation to recite -- said copy-prohibiting information exists --.

8. Claim 7 recites the limitation "copy-prohibiting information exists" in line 4. It is unclear if this copy-prohibiting information is referring to the copy-prohibiting information recited in claim 5, line 12. If they are the same, the examiner suggests amending the limitation to recite -- said copy-prohibiting information exists --.

9. Claim 8 recites the limitation "image data" in line 2. It is unclear if this image data is referring to the image data recited in claim 5, line 3. If they are the same, the examiner suggests amending the limitation to recite -- said image data --.

Claim 8 further recites the limitation "the electronically tagged printing paper" in lines 7-8. It is unclear if this printing paper is referring to the

electronically tagged printing paper recited in line 4 of claim 5 or the electronically tagged printing paper recited in lines 2-3 of claim 8. The examiner notes that, in light of the Specification wherein on pages 21-22, this claimed limitation refers to the electronically tagged printing paper recited in lines 2-3 of claim 8. If the applicant agrees with the interpretation, the examiner suggests the following changes for a clarification:

Lines 2-3, "on electronically tagged printing paper" should be -- on another electronically tagged printing paper --; and

Lines 7-8, "the electronically tagged printing paper" should be -- the another electronically tagged printing paper --.

10. Claim 9 recites the limitation "electronic data" in lines 2-3. It is unclear if this electronic data is referring to the electronic data recited in claim 5, line 5. If they are the same, the examiner suggests amending the limitation to recite -- said electronic data --.

11. With respect to claims 10, 19 and 28, arguments analogous to those presented for claim 1, are applicable.

12. With respect to claims 11 and 20, arguments analogous to those presented for claim 2, are applicable.

13. With respect to claims 12 and 21, arguments analogous to those presented for claim 3, are applicable.

14. With respect to claims 13 and 22, arguments analogous to those presented for claim 4, are applicable.

15. With respect to claims 14 and 23, arguments analogous to those presented for claim 5, are applicable.
16. With respect to claims 15 and 24, arguments analogous to those presented for claim 6, are applicable.
17. With respect to claims 16 and 25, arguments analogous to those presented for claim 7, are applicable.
18. With respect to claims 17 and 26, arguments analogous to those presented for claim 8, are applicable.
19. With respect to claims 18 and 27, arguments analogous to those presented for claim 9, are applicable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. Claims 19-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19-28 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 19-27, while defining a computer program product, do not define a "computer-readable medium" and are thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claims to state, "A computer-readable medium encoded with an image forming computer program..." in order to make the claims statutory.

21. If the applicant wishes to make the correction as suggested by the examiner, claim 28 should be canceled upon amending the claims. Also, by combining claims 19 and 28 together in one independent claim, it will make the claim statutory.

ALLOWANCE

Allowable Subject Matter

22. Claims 1-18 and 28 would be allowable if rewritten or amended to overcome the objections under 37 § CFR 1.75(a), set forth in this Office action.

23. The following is a statement of reasons for the indication of allowable subject matter:

Independent claims 1, 5, 10, 14, and 28 define an image forming device/method for printing image data stored in electronic tag, wherein said electronic tag is equipped within an electronically tagged printing paper and said tag further stores attribute information as depicted in figures 3 and 4. The claimed device/method comprises a judging unit/step for judging whether copy-prohibiting information exists in the attribute information and a reading unit/step for reading said image data from said electronic tag when said judging unit/step judges that no copy-prohibiting information exists. The claims distinguish over the prior art in that said reading unit/step does not read the image data from said electronic tag when said judging unit/step judges that copy-prohibiting information exists. The claimed combination prevents the image forming device from reading the image data from the tag when the copy-prohibition is desired.

The most relevant prior art Teraura (U.S. Patent No. 6,827,279) teaches a method of scanning a printing paper having an RFID tag for storing the copy-prohibiting field (fig. 11). Teraura further teaches the method of reading an image on the paper together with the information in the RFID tag (col. 7, lines 60-66). However, Teraura does not teach the reading unit/step for not reading the

image data from said electronic tag when said judging unit/step judges that copy-prohibiting information exists.

Many prior art references teaches the concept of reading the image data from an electronic tag mounted on a printing paper. For example, Ostrover et al. (U.S. Patent No. 6,585,154) and Tanaka et al. (Japanese Patent Publication No. 2000/0285203) teach the concept of storing image data in an electronic tag mounted on a printing paper and reading the image data from the tag for printing. However, both references do not teach the reading unit/step for not reading the image data from said electronic tag when said judging unit/step judges that copy-prohibiting information exists.

24. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact Information

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

csp
January 4, 2008

Chan S. Park
Examiner
Art Unit 2625

Chan S. Park